

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)	
	Saliba et al)	
Serial No.:	09/751,436)	Appeal No.
Confirmation No.	8755)	
Filed:	December 29, 2000)	
For:	System and Method for Secure Distribution Of Information via eMail)	
Examiner:	Chencinski, S.)	

The Honorable Commissioner of Patents
Mail Stop Appeal Brief - Patents
P.O. BOX 1450
Alexandria, VA 22313-1450

BRIEF OF APPELLANT

The Applicant has filed a timely Notice of Appeal from the action of the Examiner in rejecting all of the claims that were considered in this application. This Brief is being filed under the provisions of 37 C.F.R. § 1.192. The Filing Fee, as set forth in 37 C.F.R. § 1.17(c), is submitted herewith.

TABLE OF CONTENTS

Real Party in Interest	Page 3
Related Appeals and Interferences	Page 4
Status of Claims	Page 5
Status of Amendments	Page 6
Summary of the Claimed Subject Matter	Page 7
Grounds of Rejection to be Reviewed on Appeal	Page 11
Argument	Page 12
Claims Appendix	Page 31
Evidence Appendix	Page 44
Related Proceedings Appendix	Page 45

REAL PARTY IN INTEREST

The real party in interest is the Microsoft Corporation by way of assignment from Saliba et al., who is the named inventive entity and is captioned in the present brief.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 1-59 are pending in the application and stand rejected by the Examiner after reopening of prosecution. Therefore, the Applicant has initiated a new appeal by timely filing a notice of appeal under 37 CFR 41.31.

STATUS OF AMENDMENTS

None were filed in response to the Office Action dated March 26, 2007.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Systems and methods are described for the secure distribution of information via email. According to an exemplary implementation described beginning at page 4 of the application, a method enabling users to conduct financial transactions using email is presented. According to one aspect of the invention, bill data is received at a server implementing the method. In response, the server generates an email message with information including at least a portion of the received bill data, wherein the amount of bill data included in the email message is based, at least in part, on the email address of the recipient. According to one embodiment, the server determines how secure the link to the recipient is from the email address. If the link is deemed secure (e.g., recipient is a participant), the email message will contain substantially all of the bill data. If, alternatively, the link is determined to be less than secure (e.g., the recipient is not a participant), the email message may only contain an address where a more secure communication session may be established to view the bill data. In this way, a server incorporating the teachings of the present invention enables a participant to conduct financial transactions with another, regardless of whether the recipient is a participant, via the email system. By facilitating electronic financial transactions between participants and non-participants, it will be appreciated from the discussion to follow that the present invention solves the aggregation problem typical of prior art electronic financial systems. *See Application, page 4.*

For example, in FIG. 1 Email system 102 is shown comprising a user interface 115

with an innovative financial transaction manager (FTM) 116, a storage device 118 including email system account information, and a storage device 120 to store and maintain transaction records. Although shown separately, the email system account information and the transaction records may well be stored and maintained in a single storage device, e.g., 118, and may be integrated into a common database.

Independent claim 1 recites “a method comprising: receiving bill data (e.g., page 4, lines 5-6); and generating an email message with information including at least a portion of the received bill data, wherein the amount of bill data included in the email message is based, at least in part, on an email address of a recipient (e.g., page 4, lines 8-15), and wherein the recipient can be either a user or a non-user of a secure email system (e.g., page 4, lines 15-21), wherein no non-user had registered for a service of the secure email system (e.g., pages 11-12).

Dependent claim 3, in addition to the features of claim 1, recites “wherein the step of generating comprises: determining whether the recipient is a participant in a secure email network; and constructing the email message to include at least an address of where the bill data may be confidentially viewed if the recipient is a non-user of the secure email network” (e.g., page 4, lines 5-21).

Dependent claim 4, in addition to the features of claim 3, recites “constructing the email message to include substantially all of the bill data along with financial Multipurpose Internet Multimedia Extensions (MIME) elements which enable the recipient to manage a

financial account” (e.g., page 10, lines 5-24 and FIG. 1).

Dependent claim 7, in addition to the features of claim 3, recites “identifying a domain name from the email address; and cross referencing the identified domain name against a list of secure domain names to determine whether the recipient belongs to a secure email network.” (e.g., page 31, lines 15-31; FIG. 12A, FIG. 10, reference number 1010, 1012).

Independent claim 11 recites “a data network comprising: a plurality of computing devices (e.g., 104(a), FIG. 1), coupled to the network (e.g., reference number 112, FIG. 1), to facilitate network access by one or more participants; and an email server (e.g., reference number 102, FIG. 1), coupled to the data network and responsive to one or more of the plurality of computing devices, the data server including: a storage medium (e.g., reference number 118, FIG. 1) to store at least one financial account for each of the plurality of participants; and a financial transaction manager (e.g., reference number 116, FIG. 1), coupled to the memory device and selectively invoked by a participant, to manage access to and manipulation of financial account assets to effect requested financial transactions with any network participant or non-participant, wherein no non-participants have registered for a service of an email system supported by the email server (e.g., pages 7-11).

Independent claim 37 recites “An email system, selectively accessed by users on a data network using a computing device, the email system comprising: a user interface (e.g., FIG. 7), through which a user accesses an account associated with the user; one or more

storage devices (e.g., reference number 120, FIG. 1), to store and maintain account information for each of the users; and a financial transaction manager (e.g., reference number 116, FIG. 1), responsive to the user interface and coupled to the one or more storage devices, to manage access to and control assets of user accounts in response to user interaction with the user interface to enable the user to conduct financial transactions with another user or non-user of the email system, wherein the non-user of the email system has not registered for a service of the email system (e.g., pages 7-11).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 1, 11 and 37 were properly rejected under 35 U.S.C. § 112, second paragraph as omitting essential steps.
2. Whether Claims 1, 2, 8-19, 25, 28, 36, 37, 39, 40, 44 and 52 were properly rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 5,963,925 to Kolling et al. (hereinafter “Kolling”).
3. Whether Claim 3 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Kolling in view of U.S. Patent No. 5,930,479 to Hall (hereinafter “Hall”) and U.S. Patent No. 6,401,079 to Kahn (hereinafter “Kahn”).
4. Whether Claim 7 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Kolling and Kahn as applied to claim 3 and further in view of U.S. Patent No. 6,629,081 to Cornelius (hereinafter “Cornelius”).

ARGUMENT

First Ground of Rejection. Claims 1, 11 and 37 satisfy the requirements of 35 U.S.C. § 112, second paragraph and therefore are allowable.

The Examiner asserts that the “the omitted steps are the claim language ‘wherein the recipient can be either a user or a non-user of a secure email system. Wherein no non-user has registered for a service of the secure email system’ [sp]”. *See Office Action Dated March 26, 2007, Page 2 (hereinafter “Office Action”)*. The Examiner then goes on to assert the following:

Method steps must be in the active form of “verb + ing”. Further, MPEP 2106, II, C, states that “language that suggests or makes option but does not require step to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples(C) “wherein” clauses. *Office Action, Page 2.*

This is clearly not the case. A telephone interview was performed between the undersigned attorney, the Examiner and the Examiner’s supervisor in which the Applicant requested clarification of this rejection, as “wherein” clauses are well understood to provide patentable features and do not recite optional steps that are indefinite. During the interview, however, clarification was not forthcoming. It is respectfully submitted that such a clarification could not be offered as it is clearly erroneous. There is no “gap” in the steps as the recited language is used to provide a definition of a “non-user” as supported by the specification. It should also be noted

that this is a new rejection, as the original rejection was made under the first paragraph of 112 as not being supported by the specification, which was also clearly erroneous.

Claim 1 recites “wherein no non-user had registered for a service of the secure email system” and claim 11 recites “wherein no non-participants have registered for a service of an email system supported by the email server”. The specification, as filed, includes numerous instances which describe non-participants and non-users, portions of which are excerpted as follows:

Rather, financial transaction manager 116 only distinguishes **between “users” and “non-users” of the email system 102**, as this distinction will control whether the transaction may be carried out entirely electronically, or whether physical bills, checks, and the like will be required to complete the transaction. Thus, any user may, at a first time be a “biller” (i.e., request payment into an email system account), while at a second time be a “consumer” (i.e., purchase goods/services utilizing an email system account). *Application, Page 11 (emphasis added)*.

Moreover, unlike the EBPP systems of the prior art, **the financial transaction manager 116 enables a user to initiate financial transactions with non-users 126 of the system**, according to one aspect of the present invention. Indeed, according to certain business models to be described more fully below, **financial transactions with non-users 126 may be tailored by the financial transaction manager 116 to include a special offer/invitation to establish an account on the email system 102 and “join” the service**. In this regard, the financial transaction manager 116 enables the email system 102 to better accommodate the myriad of financial transactions performed daily by consumers, small business and large corporations alike – i.e., the financial transaction manager 116 facilitates the implementation of a truly ubiquitous financial network 100. *Application, Pages 11-12 (emphasis added)*.

According to one embodiment, the server determines how secure the link to the recipient is from the email address. If the link is deemed secure (e.g., recipient is a participant), the email message will contain substantially all of the bill data. If, alternatively, the link is determined to be less than secure (e.g., the recipient is not a participant), the email message may only contain an address where a more secure communication session may be established to view the bill data. In this way, **a server incorporating the teachings of the present invention enables a participant to conduct financial transactions with another, regardless of whether the recipient is a participant, via the email system.** By facilitating electronic financial transactions between participants and non-participants, it will be appreciated from the discussion to follow that the present invention solves the aggregation problem typical of prior art electronic financial systems. *Application, Page 4 (emphasis added).*

This invention concerns a system and method **facilitating personal electronic financial transactions with anyone, including non-users of the system and methods, via an email system.** *Application, Page 7 (emphasis added).*

Fig. 1 illustrates an example network 100 including an email system 102 with an innovative financial transaction manager 116, which enables any user of the email system to conduct financial transactions with other users and non-users alike. *Application, Page 8.*

Thus, as shown in the above excerpted portions of the application, users and non-users, as well as participants and non-participants, are defined based on their relationship to the system, e.g., the email system. Non-participants may “join” the service, which thereby results in registration to the service. *See Application, Pages 11-12.* Further, even before “joining”, non-users may participate in financial transactions with users of the service, e.g., “the financial transaction manager 116 enables a user to initiate financial transactions with non-users 126 of the system”, “financial transactions with non-users 126 may be tailored by the financial transaction manager

116 to include a special offer/invitation to establish an account on the email system 102 and ‘join’ the service”. *See Application , Pages 11-12*. Thus, it is readily apparent that a non-user that has not registered for a service of the secure email system may receive the email message from the secure email system.

Accordingly, the features of claim 1 which recite “wherein no non-user had registered for a service of the secure email system” and the features of claim 11 which recite “wherein no non-participants have registered for a service of an email system supported by the email server” are supported by the specification. The Applicant respectfully requests the Board to overturn the First Ground of Rejection.

Second Ground of Rejection. Claims 1, 2, 8-19, 25, 28, 36, 37, 39, 40, 44 and 52 satisfy the requirements of 35 U.S.C. § 102(e) and therefore are patentable over Kolling.

1. **Kolling Requires Consumers to Register for a Service**

Kolling describes an electronic statement presentment system. In relation to FIG. 8 of Kolling, an embodiment is described by which a consumer enrolls in an electronic statement presentment (ESP) system, which is described in Kolling as one technique by which a consumer may subscribe to the ESP service. An available subscription is equivalent to the identification of an in-service template, and a subscription may be viewed as a unique relationship between a template identifier and a customer's biller account number (CBAN). Once a subscription has been confirmed, a billing relationship is established between a consumer and a biller. *See Kolling, Col. 25, Lines 45-54.* The biller is also a participant in the Kolling system. *See Kolling, FIG. 2 and related discussion at Col. 7, Line 25 to Col. 8, Lines 35.* Thus, Kolling requires registration before a relationship is established.

2. **Applicant describes Transactions that may involve Users and Non-Users of a System**

Beginning at page 11 of the subject application, Applicant describes an exemplary embodiment in which, unlike the electronic bill presentment and payment (EBPP) systems of the prior art, the financial transaction manager 116 enables a user to initiate financial transactions with non-users 126 of the system, according to one

aspect of the present invention. Indeed, according to certain business models to be described more fully below, financial transactions with non-users 126 may be tailored by the financial transaction manager 116 to include a special offer/invitation to establish an account on the email system 102 and “join” the service. In this regard, the financial transaction manager 116 enables the email system 102 to better accommodate the myriad of financial transactions performed daily by consumers, small business and large corporations alike – i.e., the financial transaction manager 116 facilitates the implementation of a truly ubiquitous financial network 100. *Application, Pages 11-12 (emphasis added).*

3. **Claims 1, 2, 8-19, 25, 28, 36, 37, 39, 40, 44 and 52 are Not Anticipated by Kolling**

It should be noted that the Examiner asserts that “the claim language ‘wherein the recipient can be either a user or a non-user of a secure email system. Wherein no non-user has registered for a service of the secure email system’ is not given patentable weight for the reasons stated in the above 35 USC 112-2nd paragraph rejection”. *See Office Action, Page 3.* This is clearly improper. First, it is interesting to note that the Examiner did attempt to address these limitations in the previous Appeal, but was unable to do so as Kolling does not disclose “non-users” as further detailed in the arguments below. Second, failure of the Examiner to give patentable weight to these features is clearly improper. As the Examiner readily admits, these features were not addressed, therefore a *prima facie* case of anticipation has not been

established.

As previously stated, Kolling's system requires consumers to, in effect, register for a service, e.g., in FIG. 8, block 708 of Kolling a "consumer requests electronic statement subscription for a biller". The Examiner asserted the following portions of Kolling in rejecting the recited features of Claim 1:

It is important for a biller to deliver an invoice to a consumer so that the consumer may then pay the bill presented in the invoice. *Kolling, Col. 3, Lines 14-16.*

Although the present invention may operate stand-alone, in one embodiment of the invention the electronic statement presentment (ESP) system is an enhancement, or is complimentary to any suitable electronic bill payment system. In one specific embodiment, the ESP system is an enhancement to the electronic bill payment system described in U.S. Pat. No. 5,465,206, and in particular may be integrated with VISA's ePay system to provide full-circle electronic financial transactions for billers and consumers. By introducing electronic statement presentment to an existing electronic bill payment system, an added dimension enables fully automated bill payment. *Kolling, Col. 4, Lines 30-41.*

A bank or other consumer service provider may also integrate such an electronic statement delivery from a biller into its own electronic home banking product in order to enhance that product and to provide more value to its consumer. In this fashion, a consumer may continue a relationship with his current bank, yet still be able to receive electronic statements from any biller from which the consumer receives a service. Alternatively, a consumer may choose any consumer service provider it desires that might provide electronic statements by way of the present invention. Thus, the present invention enhances the value of the consumer financial institution or consumer service provider in the eyes of the consumer. *Kolling, Col. 5, Lines 17-29.*

The consumer financial institution may then use any of a variety of means to transmit this electronic statement to the consumer. For

example, any electronic home banking service that the consumer financial institution supports may be used to transmit the electronic statement to the consumer. Electronic means such as the Internet, telephones, video telephones, televisions, WebTV, personal digital assistants, or any other proprietary communication system may be used. *Kolling, Col. 5, Lines 42-50.*

To begin enrollment, in step 704 the CSP advertises biller availability in providing electronic statements to consumers. This advertisement may take place in any of a variety of media that the CSP uses to communicate with its customers such as over the Internet, electronic mail, regular mail, telephone, newspaper advertisements, etc. *Kolling, Col. 26, Lines 25-30.*

As shown in the above excerpted portions, however, Kolling merely describes integrating “the electronic statement presentment (ESP) system” with an “electronic bill payment system”. Neither the above excerpted portions of Kolling, nor elsewhere in the Kolling reference, is there disclosure for users and non-users as recited in Claim 1. Rather, Kolling describes that each user is enrolled in the system. *See Kolling, FIG. 8 and accompanying discussion at Col. 27, Lines 37-55.*

The Examiner previously asserted that “Kolling provides the option of sending the billing message through a third party, such as the user’s financial institution or the user’s billing service, Kolling does not require users to be registered with the original sender of the billing message.” *See Office Action Dated March 27, 2006, Pages 5-6.* The Examiner then again asserted the portions of Kolling excerpted above. However, Kolling describes the integration of this system into an existing system, and therefore the user is again registered with that system. For example, Kolling describes that in

an embodiment “the ESP system is an enhancement to the electronic bill payment system described in U.S. Pat. No. 5,465,206, and in particular may be integrated with VISA's ePay system to provide full-circle electronic financial transactions for billers and consumers”. *Kolling, Col. 4, Lines 30-41*. Nowhere does this passage teach or suggest that the system may act as an intermediary as asserted by the Examiner, but rather this section clearly asserts that it is not separate a “stand-alone system” in this embodiment but is integrated within another system. *Id.* Further, this integration specifically follows the previous recitation and does not make any provision for modification other than integration with the system. Thus, the integrated Kolling system still requires registration on the part of users, any other reading of this passage would be clearly improper based on impermissible hindsight reconstruction.

Further, Claim 1 recites “wherein the amount of bill data included in the email message is based, at least in part, on an email address of a recipient”. The Examiner in the present Office Action ignored these features, but asserted the following portions of Kolling in rejecting this recited feature in the previous Office Action, which are excerpted as follows:

A CFI associated with each SGEN delivers each electronic statement to the appropriate customer using a customer identifier in the statement data and uses any chosen medium. *Kolling, Abstract*.

Whereas billers currently use an invoicing system to print statements on paper for mailing, the present invention is able to retrieve electronic statement data from invoicing system 204 for eventual generation of an electronic statement. Statement data 206 sent to biller 102 includes all

of the data normally found in an invoice or a statement for a particular consumer. In one specific embodiment, statement data 206 is transmitted in the form of a statement augmented record (SAR) when the data is sent from biller 102 to SORG 208 and includes the identifier and version of the template that the biller wishes to use in preparing an electronic statement for its customers. Typically, a biller will send a batch or billing round of statement data for numerous customers all at once, although statement data 206 may be sent for a single customer as well.

Template authoring workstation (TAWS) 210 is a computer that may be physically located at, or operated by, the biller, the BSP or the BFI. TAWS 210 utilizes current off-the-shelf authoring software packages and software described herein to create templates that contain the biller's processing instructions for displaying statements and invoices. A template contains the programmed instructions and graphic pattern for statement information to be presented to the consumer and is described in more detail below in FIG. 5. *Kolling, Col. 9, Lines 34-55.*

Although the above excerpted portions describe “generation of an electronic statement”, Kolling does not teach or suggest “the amount of bill data included in the email message is based, at least in part, on an email address of a recipient” as recited in Claim 1. Indeed, there is no mention whatsoever of a relationship between an email address and an amount of bill data in Kolling. Rather, the Examiner asserted that “Kolling adjusts the amount of information to fit the medium”. *See Office Action Dated January 27, 2005, Page 3.* It is respectfully submitted that this is not the recited feature.

The Examiner further asserted the following in the previous Office Action, and therefore although not asserted in the present Office Action, is addressed as follows for the sake of completeness:

Kolling teaches a system which effects electronic presentment (i.e. delivery) of billing statements and invoices; ll. 30-31 – through “any chosen medium”; Col. 9. ll. 37-55. Kolling adjusts the amount of information to fit the medium. This suggests that there is flexibility (Col. 4, l. 63 – Col. 5, l. 67). Kolling also teaches a method and system whereby a consumer is sent a message to log on to a web site through the Internet in order to access the consumer’s invoice (Col. 3, ll. 40-45). Even though this is a less efficient method for which Kolling teaches a more efficient replacement, the method still remains valid and suggests to the ordinary practitioner that if there is no secure electronic means to send the full billing information such a limited message advising the consumer recipient still has value in order to protect all the parties involved. Such a two step method could obviously be incorporated into other elements of Kolling’s teaching and an ordinary practitioner of the art at the time of the Applicant’s invention would have seen the obvious combination of these teaching and suggestions within Kolling. Further, Kolling teaches numerous electronic and non electronic ways for delivery of the billing message, including the Internet, which is an email method (see above). Thusly, the origination of the billing message by electronic means suggests that an email address is at least in part in the recipient’s bill data file passed by the sender, since otherwise a non electronic means would have to be used to send the billing message to the consumer recipient. It is obvious that an email address related to the recipient is also at least in part in the recipient’s bill data file possessed by the second or final sender in the relay options taught by Killing. However, it is also a part of Kolling’s teaching to include means of non-electronic billing message delivery of electronic means of connection (i.e., electronic address information) are not found in the data file related to the billing recipient.)” *See Office Action, Page 5.*

First, the Applicant is unclear as to the purpose of the assertion by the Examiner that “Kolling teaches a more efficient replacement”, as clearly there is no such requirement in the statutes or rules. Regardless, even though the excerpted portion provides a lengthy discussion of an email address, it still does not provide a basis in Kolling for teaching or suggestion of “the amount of bill data included in the email

message is based, at least in part, on an email address of a recipient” as recited in Claim 1. Rather, it is respectfully submitted that the above excerpted portion merely shows that the Examiner is asserting that Kolling would use an email address. However, this excerpted portion does not show how Kolling teaches or suggests use of the email address to base an amount of bill data. Rather, as repeatedly admitted by the Examiner, this determination is based on the medium.

Additionally, in the rejection of **Claim 11**, as previously described in relation to Claim 1, Kolling merely describes integrating “the electronic statement presentment (ESP) system” with an “electronic bill payment system”. Neither the above excerpted portions of Kolling, nor elsewhere in the Kolling reference, is there disclosure for the recited feature of Claim 11. Rather, Kolling describes that each user is enrolled in the system. *See Kolling, FIG. 8 and accompanying discussion at Col. 27, Lines 37-55.* Further, the Examiner has again refused to give patentable weight to “non-users” which is clearly improper as stated above and therefore a *prima facie* case of anticipation has not been established as admitted by the Examiner.

Claim 37 recites, in part, “a financial transaction manager ... to manage access to and control assets of user accounts in response to user interaction with the user interface to enable the user to conduct financial transactions with another user or non-user of the email system, wherein no non-user of the email system has registered for a service of the email system”. The Examiner asserted the following portion of Kolling

in rejecting this feature:

Although the foregoing invention has been described in some detail for purposes of clarity of understanding, it will be apparent that certain changes and modifications may be practiced within the scope of the appended claims. For instance, the invention may be integrated with any suitable electronic bill payment system. The functionality of the coordinating entity, including the functionality of the TAWS, the SORG, the switch, the SGEN, the TVAL, etc., may be distributed throughout the ESP environment, and may be implemented on separate computers or the functionality may be combined on fewer computers. In particular, the functionality of the SORG, the switch and the SGEN may be implemented centrally on a single computer, or may be implemented on separate computers. Furthermore, both the SORG and SGEN may be located remotely at a biller and CSP, respectively. Also, the central site switch may be implemented using various computers performing different aspects of the switch functionality. For example, one computer may assist with ESP system functionality, while another assists with an electronic bill payment system. In addition, any format of data from a biller can be used, and the invention is capable of producing statements in a variety of data formats, including PDF, EDI 810, HTML, etc. Furthermore, statements, invoices, account updates, bills, or information of any kind may be transmitted using the present invention from a biller to one of its customers. For presentation of the information to a customer, any of a variety of media may be used to transmit and display the information from a CSP to the customer. Therefore, the described embodiments should be taken as illustrative and not restrictive, and the invention should not be limited to the details given herein but should be defined by the following claims and their full scope of equivalents. *Kolling, Col. 34, Lines 35-67.*

As shown in the above excerpted portion, Kolling does not disclose, teach or suggest a “user” or “non-user”. Indeed, the asserted portion does not even include the word “user”. Rather, the asserted portion merely describes that the system of Kolling may be implemented on separate computers and that statements may be transmitted using a variety of media. Again, as previously stated in relation to Claims 1 and 11, Kolling

merely describes integrating “the electronic statement presentment (ESP) system” with an “electronic bill payment system”. Neither the above excerpted portions of Kolling, nor elsewhere in the Kolling reference, is there teaching or suggestion for the recited feature of Claim 37. Rather, Kolling describes that each user is enrolled in the system. *See Kolling, FIG. 8 and accompanying discussion at Col. 27, Lines 37-55.* Further, the Examiner has again refused to give patentable weight to “non-users” which is clearly improper as stated above and therefore a *prima facie* case of anticipation has not been established as admitted by the Examiner.

Claims 2, 8 and 10 depend either directly or indirectly from Claim 1 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in Claim 1, are neither shown nor suggested in the references of record, either singly or in combination with one another.

Claims 12-36 depend either directly or indirectly from Claim 11 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in Claim 11, are neither shown nor suggested in the references of record, either singly or in combination with one another.

Claims 38-59 depend either directly or indirectly from Claim 37 and are allowable as depending from an allowable base claim. These claims are also

allowable for their own recited features which, in combination with those recited in Claim 37, are neither shown nor suggested in the references of record, either singly or in combination with one another.

The Applicant respectfully requests the Board to overturn the Second Ground of Rejection.

Third Ground of Rejection. Claim 3 satisfies the requirements of 35 U.S.C. § 103(a) such that this claim is patentable over Kolling in view of Hall and Kahn.

Dependent claim 3, in addition to the features of claim 1, recites “wherein the step of generating comprises: determining whether the recipient is a participant in a secure email network; and constructing the email message to include at least an address of where the bill data may be confidentially viewed if the recipient is a non-user of the secure email network” (e.g., page 4, lines 5-21).

The Examiner asserts that “disregarding the security status of the intended URL address would have been obvious to the ordinary practitioner”. *See Office Action, Page 7*. This is not the claimed feature and the Applicant is unclear as to the relevance of the statement.

The Examiner then also asserts the following:

The ordinary practitioner would have recognized the ubiquitous use of URL's which provide an opportunity for any operator of a web site, such as a biller or biller agent's web site, to notify an e-mail user to log on to an internet address (by direct link or not) for many purposes, such as for viewing secure bill data if the email user's network is of an unknown security level. Kolling discloses such an arrangement in Col. 3, ll. 40-46. An unknown security condition would be the case if the email user is not registered with the biller of the biller's agent. It would therefore have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling with that of Hall and Kahn in order to reduce the barriers to increased usage by individuals and smaller business entities which exist in conventional electronic bill presentment and/or payment system, motivated by a desire to provide a system and method for controlling the reception of

communications from various entities having access to the network (Hall, Col. 1, ll. 8-10). *See Office Action, Pages 7-8.*

However, this is not the case as previously described Kolling does not contemplate “non-users” of the system and therefore the Examiner’s proposed modification to provide such contemplation is not supported by the references. In each case, Kolling clearly necessitates registration with the system and therefore would not send the emails proposed by the Examiner to persons that are not registered. Neither Hall nor Kahn, alone or in combination, remedies this defect. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established and withdrawal of the rejection is respectfully requested.

Fourth Ground of Rejection. Claim 7 satisfies the requirements of 35 U.S.C. § 103(a) such that this claim is patentable over Kolling in view of Cornelius.

Claim 7 depends from Claim 1. As discussed above, Claim 1 is patentable over Kolling. Cornelius is cited as disclosing, “identifying a domain name from the email address; and cross referencing the identified domain name against a list of secure domain names to determine whether the recipient belongs to a secure email network.”

Applicants respectfully assert that the cited portion of Cornelius does not teach or suggest identifying a domain name from an email address. Rather, the cited portion of Cornelius appears to be directed to the firewalls shown in FIGS. 37 and 38. As can be seen in FIGS. 37 and 38, the firewalls are directed to protecting web servers and not email servers. Further, the cited portion of Cornelius does not mention email address; instead it lists “user names and passwords, Internet IP address or domain name.” There is no indication of where the domain is obtained. Moreover, the disclosure of web servers in FIGS. 37 and 38 would indicate that the domain name is obtained from web address and not an email address. Therefore, the listing of multiple security techniques does not teach or suggest identifying a domain name from an email address.

The Applicant respectfully requests the Board to overturn the Fourth Ground of Rejection.

CONCLUSION

The Applicant respectfully considers this application to be in condition for allowance and respectfully request the Board to overturn the final rejection and that the Examiner pass this application to allowance.

Dated this 17th day of September, 2007.

Respectfully submitted,

/William J. Breen, III, #45,313/

WILLIAM J. BREEN, III

Attorney for Applicant

Registration No. 45,313

Sadler, Breen, Morasch and Colby, p.s.

422 W. Riverside Avenue, Suite 424

Spokane, WA 99201

Telephone: (509) 755-7253

Facsimile: (509) 755.7252

APPENDIX: CLAIMS ON APPEAL

Listing of Claims:

1. A method comprising:

receiving bill data; and

generating an email message with information including at least a portion of the received bill data, wherein the amount of bill data included in the email message is based, at least in part, on an email address of a recipient, and wherein the recipient can be either a user or a non-user of a secure email system, wherein no non-user has registered for a service of the secure email system.

2. A method according to claim 1, further comprising:

sending the email message to the recipient.

3. A method according to claim 1, wherein the step of generating comprises:

determining whether the recipient is a participant in a secure email network; and

constructing the email message to include at least an address of where the bill data may be confidentially viewed if the recipient is a non-user of the secure email network.

4. A method according to claim 3, further comprising:

constructing the email message to include substantially all of the bill data along with

financial Multipurpose Internet Multimedia Extensions (MIME) elements which enable the recipient to manage a financial account.

5. A method according to claim 4, wherein the MIME elements enable the recipient to pay all or part of the received bill.

6. A method according to claim 4, wherein the MIME elements enable the recipient to establish and manage a financial account.

7. A method according to claim 3, wherein the step of determining comprises:
identifying a domain name from the email address; and
cross referencing the identified domain name against a list of secure domain names to determine whether the recipient belongs to a secure email network.

8. A method according to claim 1, further comprising:
receiving the sent email message including at least a portion of the bill data at the recipients email address; and
displaying at least a portion of the message in an inbox of an email client used by the recipient to access their email account.

9. A method according to claim 8, further comprising:

displaying the email message in the email client of the recipient, upon user access of the email message, wherein the email message includes financial Multipurpose Internet Mail Extension (MIME) elements that enable the recipient to pay some or all of the received bill.

10. A method according to claim 8, further comprising:

paying some or all of the received bill by responding to the email

11. A data network comprising:

a plurality of computing devices, coupled to the network, to facilitate network access by one or more participants; and

an email server, coupled to the data network and responsive to one or more of the plurality of computing devices, the data server including:

a storage medium to store at least one financial account for each of the plurality of participants; and

a financial transaction manager, coupled to the memory device and selectively invoked by a participant, to manage access to and manipulation of financial account assets to effect requested financial transactions with any network participant or non-participant, wherein no non-participants have registered for a service of an email

system supported by the email server.

12. A data network according to claim 11, wherein the financial account is electronically linked to an account of the participant at a financial institution.

13. A data network according to claim 12, wherein the account of the participant is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution.

14. A data network according to claim 11, wherein the financial account is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution.

15. A data network according to claim 11, wherein the computing devices are one or more of a personal computer, a personal digital assistant, a kiosk, a telephone and a set-top box having sufficient resources to enable the participant to access the data server and utilize the financial transaction manager.

16. A data network according to claim 11, further comprising an email system having a plurality of data servers including the data server.

17. A data network according to claim 11, wherein the data server is controlled by a financial institution.

18. A data network according to claim 11, wherein the financial transaction manager selectively transfers assets from a first participant's account to a second participant's account in response to a request by the first participant to transfer such assets.

19. A data network according to claim 18, wherein each of the first and second participants are individual consumers, a business, or a combination of each.

20. A data network according to claim 18, wherein the first participant does not have a priori knowledge of the second participant's account information, but identifies the second participant from a list of network participants.

21. A data network according to claim 20, wherein the second participant is identified by one of a name, an alias, or an email address.

22. A data network according to claim 11, wherein the financial transaction manager selectively receives assets for deposit in an account of a participant.

23. A data network according to claim 22, wherein the assets are received from a brokerage at the request of the participant.

24. A data network according to claim 22, wherein the assets are received from an employer as compensation to the participant.

25. A data network according to claim 11, wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service.

26. A data network according to claim 25, wherein the network service is an electronic auction service.

27. A data network according to claim 25, wherein the network service is an electronic retail service.

28. A data network according to claim 25, wherein the financial transaction

manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant.

29. A data network according to claim 28, wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment.

30. A data network according to claim 29, wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment.

31. A data network according to claim 29, wherein the financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment.

32. A data network according to claim 31, wherein the financial transaction manager notifies the participant of the insufficient funds and that the line of credit has been accessed to honor the requested payment.

33. A data network according to claim 25, wherein the financial transaction

manager issues an instruction to have a check issued and sent to an address specified by the request, upon authorization of the participant.

34. A data network according to claim 33, wherein the issued check includes a uniform resource locator (URL) address of a web page offered by the data server where the recipient can establish an account.

35. A data network according to claim 34, wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check.

36. A storage medium having stored thereon a plurality of executable instructions which, when executed, implement a financial transaction manager according to claim 11.

37. An email system, selectively accessed by users on a data network using a computing device, the email system comprising:

a user interface, through which a user accesses an account associated with the user;
one or more storage devices, to store and maintain account information for each of the users; and

a financial transaction manager, responsive to the user interface and coupled to the one or more storage devices, to manage access to and control assets of user accounts in

response to user interaction with the user interface to enable the user to conduct financial transactions with another user or non-user of the email system, wherein no non-user of the email system has registered for a service of the email system.

38. An email system according to claim 37, wherein the user interface is series of instructions issued to a computing device of the user to create a web page at the computing device.

39. An email system according to claim 37, wherein the user interface is a series of instructions issued to an email client executing on a computing device of the participant.

40. An email system according to claim 37, wherein the financial transaction manager selectively transfers assets from a first user's account to a second user's account in response to a request by the first user to transfer such assets.

41. An email system according to claim 37, wherein the financial transaction manager causes a check to be printed and sent to another at the request of a user.

42. An email system according to claim 41, wherein the check includes an offer to create an account at the email system.

43. An email system according to claim 40, wherein each of the first and second users are individual consumers, or businesses.

44. An email system according to claim 40, wherein the first user does not have a priori knowledge of the second user's account information, but identifies the second participant from a list of network participants provided by the financial transaction manager.

45. An email system according to claim 40, wherein the second user is identified by one or more of the user's name, alias, or email address.

46. An email system according to claim 37, wherein the financial transaction manager selectively receives assets for deposit in an account of a participant.

47. An email system according to claim 46, wherein the assets are received from a brokerage at the request of the participant.

48. An email system according to claim 46, wherein the assets are received from an

employer as compensation to the participant.

49. An email system according to claim 37, wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service.

50. An email system according to claim 49, wherein the network service is an electronic auction service.

51. An email system according to claim 49, wherein the network service is an electronic retail service.

52. An email system according to claim 49, wherein the financial transaction manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant.

53. An email system according to claim 52, wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment.

54. An email system according to claim 52, wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment.

55. An email system according to claim 52, wherein the financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment.

56. An email system according to claim 25, wherein the financial transaction manager issues an instruction to have a check issued and sent to an address specified by the request, upon authorization of the participant.

57. An email system according to claim 33, wherein the issued check includes a uniform resource locator (URL) address of a web page offered by the data server where the recipient can establish an account.

58. An email system according to claim 34, wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check.

59. A storage medium having stored thereon a plurality of executable instructions

which, when executed, implement an email system according to claim 37.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.